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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Michael KOCHMAN, et al.
Serial Number: 09/552,586
Filed: April 19, 2000
For: MASSAGER PROVIDING RADIANT HEAT AND MECHANICAL
MANIPULATION
Examiner: YU, JUSTINE ROMANG
Art Unit: 3764

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APPEAL BRIEF

Sir:

Further to a Final Office Action dated June 25, 2003 and a Notice of Appeal filed on November 25, 2003, the following is applicants brief on appeal.

(1) Real Party of Interest:

The real party of interest in the present application is Tensor Technologies LLC of 32 Timber Trail, Ramsey, NJ 07446, USA. A company incorporated under the laws of the state of New-Jersey.

(2) Related Appeals and Interferences:

None

(3) Status of claims:

Claims 48-50 are the only claims presently pending in the application and all are rejected under 35 USC 103(a) as being unpatentable over Blecker et al. (U.S. 6,017,320) in view of Cheng. (U. S. 5,336,159).

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Arguments in a letter filed on September 24, 2003 in response to the final office action were not considered convincing and did not place the application in condition for allowance. (See Advisory Actions of October 21, 2003 and December 16, 2003)

(4) Status of Amendments:

No amendment was filed after final.

(5) Summary of the Invention:

Cellulites are lumpy fat deposits that commonly aggregate around the hips of females and the waists of males, degrade appearance of a person's skin and tend to make the person look older. Many people invest substantial cosmetic effort to combat cellulites and improve their personal appearance. Often massages are used to combat cellulites.

According to an aspect of an embodiment of the present invention, a mechanical massage device is provided, which makes it possible to perform massages that are more effective in reducing and combating cellulites than prior art massagers. A massager in accordance with the present invention comprises at least one rotatable massaging element, a vacuum pump and a radiant heat source and may be used to apply a combination of radiant heat, suction by vacuum and mechanical massage to a region of a person's skin to combat cellulites.

(6) Issues:

Whether claims 48-50 are patentable over U.S. 6,017,320 to Blecker et al. in view of US 5,336,159 to Cheng.

(7) Grouping of the Claims

Claims 48-50 stand or fall together, based on the art cited.

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(8) Argument:

The Examiner has not made a *prima facie case* of obviousness with respect to claim 48.

Independent claim 48 recites a massager that combines a rotatable massaging element, vacuum and radiant heat for reducing effects of cellulite on appearance of a region of a person's skin. In a final office action mailed June 25, 2003 the Examiner contends that the combination of massaging element, vacuum and heat are *prima facie* obvious over Blecker (U.S. 6,017,320) and Cheng (US 5,336,159) and therefore unpatentable under 35 U.S.C. 103(a).

The Examiner supports her contention by noting "Blecker teaches a massaging apparatus comprising rollers and a suction chamber within a housing 2. Blecker lacks a heat source. However, Cheng teaches a radiant heat source 32 for applying heat to the tissue. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Blecker's apparatus with a radiant heat source as taught by Cheng, so as to enhance the massaging effect."

Applicants point out that the support statement does not objectively show *why it is obvious to one* of ordinary skill in the art to combine Blecker and Cheng but only repeats that it is obvious to do so. Applicants therefore submit that the support statement does not rise to support *prima facie* obviousness, which as taught *In re Fine* may be established "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references".

Furthermore, the statement appears to imply that since Blecker and Cheng exist it is obvious to combine them and modify Blecker in view of Cheng to provide the invention of claim 48. Applicants respectfully rebut the implied syllogism of the statement with reference to *In re Fritch* (CAFC) 23 USPQ2d 1780 (8/11/1992), which teaches that "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

Arguments similar to those made above were made by applicants in a response to the June 25, 2003 Final Office action filed on September 24, 2003. In a first Advisory Action mailed on October 21, 2003 the Examiner stated that the arguments were not persuasive but did attempt to buttress the case for *prima facie* obviousness by noting that "It is well known in the

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massage art to apply heat to enhance the effectiveness of massage. This is also supported by at least Henderson (US 4,086,922)."

In a second Advisory Action mailed on December 16, 2003 in response to a Notice of Appeal filed on November 25, the Examiner repeats that applicants arguments are not persuasive and adds that "The examiner sees Cheng as providing clear motivation to combine motor-operated massaging devices, such as the Bleeker device, with infrared device to provide heat for stimulating muscles as the muscles are massaged by the motor-operated devices." The examiner continues, "Further support for the combination is provided by Henderson, which applicant has not responded to. Henderson discloses a massage device wherein heat is applied in the treatment of cellulite, in combination with a roller massage device. Though Henderson is not part of the formal rejection, it is further evidence supporting the combination of infrared devices with the Bleeker device."

Applicants respectfully traverse that Henderson supports combining Bleeker and Cheng to provide the invention of claim 48. As noted in a response filed on February 7, 2002 to a first final Office Action dated November 30, 2001, Cheng describes a massager for using infrared radiant heat for "stimulating the muscles and joints" (column 1 lines 23-24, column 2 lines 29-32). Bleeker on the other hand describes a massager for treating the skin and in particular for using a vacuum to treat the skin by forming folds in the skin (column 1 lines 28-29, column 2 lines 23-24 as referencing the opening paragraph, and in claim 1 column 14 line 3). Cheng's massager and Bleeker's massager are intended for different treatments and respectively teach use of radiant heat and vacuum for different purposes.

Of the three cited patents, Bleeker, Cheng and Henderson, only Henderson describes a massager for treating cellulite. The Henderson massager comprises rotating massage elements (balls) and "controlled heating means" for heating the balls, (e.g. column 3 line 51) which in turn transmit heat to a region being massaged by convection. Henderson does not teach or in any way imply use of radiant heat for the purpose of treating cellulite and does not therefore provide impetus for combining radiant heat with a massage element to treat cellulite. But in addition, Henderson repeatedly teaches that the balls are designed to "apply substantially uniform pressure over the area" of a persons body that they contact (e.g. column 1, lines 34,35, column 2, lines 19-21, column 3, lines 33-35, column 4, lines 18-20, lines 48-50). In contradistinction to Henderson, Bleeker's massager, which employs a vacuum to form folds in

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the skin must be understood to generate large variations in pressure over an area of a person's body to which it is applied.


Applicants submit that Henderson, for purposes of treating cellulite, not only does not provide impetus for use of radiant heat but teaches away from combining heat with a device, *i.e.* a vacuum device, which generates large pressure differentials over a region of a person's skin. Therefore, not only is it not obvious to combine the Blecker and Cheng massagers because they are intended for different treatments and respectively teach use of radiant heat and vacuum for different purposes but the only cellulite massager referred to, Henderson's, must be understood to teach away from making the combination.

In view of the above arguments applicants submit that the Examiner has not established a *prima facie* case for obviousness of the present invention over Blecker in view of Cheng and it would not be obvious to combine Blecker and Cheng to provide the invention of claims 48-50.

(9) Conclusion

None of the claims pending in the present application are obvious in view of the prior art cited. Applicants respectfully request that the Board reverse the ruling of the examiner and allow all the claims.

Respectfully submitted,
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Appendix - Claims under Appeal

48. A massaging apparatus for reducing effects of cellulite on appearance of a region of a person's skin comprising:

a housing;

at least one massaging element rotatable within the housing, and extending from the housing so that the at least one massaging element is positioned to manipulate the region and underlying cellulite tissue when the apparatus is applied to the region;

a vacuum pump that generates a low pressure region within the housing, said low pressure region being operative to draw the region of skin and underlying cellulite towards the housing when the apparatus is applied to the region; and

a radiant heat source mounted to the housing that provides radiant heat operative to heat the cellulite tissue when the apparatus is applied to the region.

49. The massaging apparatus of claim 48 wherein the radiant heat is characterized in that it substantially passes through skin.

52. A method according to claim 51 wherein illuminating the region with radiant heat comprises illuminating the region with light having a wavelength in the range from 600 nm to 1500 nm.